

Appl. No. 09/653,555
June XX, 2004
PROPOSED Reply to Office Action of April 6, 2004

PATENT

II. REMARKS

Claims 2-5 and 7-14 were cancelled without prejudice. Two independent claims 15 and 45 and 40 dependent claims 16-44 and 46-57 were added to more clearly define the subject matter of the invention and thereby place all of the claims remaining in the application in condition for allowance. Claim 45 is broader than claim 15. Claims 15-57 are pending in the present application. No new matter was presented and such amendments are deemed unobjectionable. For the convenience of the Examiner, Applicants have provided cites of support to the patent application in an exemplary independent claim, which can be found at the end of this reply and amendment. Applicants assert that all of the newly added claims are similarly supported by the record. Entry of the amendment is respectfully requested. It is also respectfully requested that the Examiner reconsider the present application and claims as currently pending in view of the following remarks.

A. Interview

Applicants gratefully acknowledge the Examiner interview of June 25, 2004 and appreciate the Examiner's time and consideration. During the interview, pending claims and prior art of record were discussed. It was agreed that a Rule 1.111 Reply would be filed and the application reconsidered. Applicants are grateful for the Examiner's offer to record the Interview Summary and respectfully note that as of the mailing of the present Reply, an Interview Summary had not been received confirming the Interview on June 25, 2004.

B. Continued Examination

Applicants gratefully acknowledge the Examiner's withdrawal of the finality of the previous Office Action and entry of Applicants' submission filed on November 26, 2003.

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Applicants gratefully acknowledge the Examiner's approval of the drawings received on June 6, 2003.

D. Claim Rejections Under 35 U.S.C. § 103

The Office Action rejected claims 3 through 5, 7 through 10, and 12 through 14 under 35 U.S.C. § 103 as being unpatentable over The American Council for an Energy-Efficient Economy (ACEEE) in view of Official Notice regarding obtaining data over the Internet and www.bbbonline.org. The Office Action further rejected claims 2 and 11 under 35 U.S.C. § 103 as being unpatentable over The American Council for an Energy-Efficient Economy (ACEEE) in view of Official Notice regarding obtaining data over the Internet and www.bbbonline.org and further in view of the "Fuel economy" reference from Consumers Research Magazine. Applicants respectfully traverse each of the 35 U.S.C. § 103 rejections set forth herein in view of the newly added claims and for the reason that Applicants' invention is patentably distinguishable, and not an obvious improvement, over the cited references.

1. No *Prima Facie* Case of Obviousness

In order to establish a *prima facie* case of obviousness according to MPEP § 706.02(j), the cited references must teach or suggest all of Applicant's claim limitations, and there must be some suggestion or motivation to modify a reference or to combine reference teachings.

a. Missing Elements

Foremost, it is apparent that the cited references do not teach all of Applicants' claim limitations. Even assuming, *arguendo*, that there is a suggestion or motivation to combine

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the cited references, there are fundamental differences between the claimed invention and the individual cited references and any combination thereof, such that all of the claim limitations of Applicants' invention are not met by ACEEE, Official Notice, or www.bbbonline.org, or any combination thereof.

Applicants' independent claim 15 recites, *inter alia*, a step of developing forecasts of sales of vehicle configurations, and a step of developing environmental performance scores for vehicle models by sales-weighting environmental performance values of environmental data components by the forecasts of sales. Also, Applicants' independent claim 45 recites, *inter alia*, a step of developing forecasts of sales of product configurations, and a step of developing environmental performance scores for product models by sales-weighting environmental performance values of environmental data components by the forecasts of sales.

The Applicants respectfully assert that there are significant differences between Applicants' invention and ACEEE, Official Notice, www.bbbonline.org, or the "Fuel economy" reference, or any combination thereof. Any combination of the aforementioned references fails to disclose, teach, or suggest a step of developing forecasts of sales of product or service configurations, and a step of developing environmental performance scores for product or service models by sales-weighting environmental performance values of environmental data components by the forecasts of sales. The ACEEE reference, Official Notice, www.bbbonline.org, and the "Fuel economy" reference individually and collectively fail to disclose, teach, or suggest anything about sales-weighting any data of any kind by forecasts of sales of vehicle, product, or service configurations. In fact, the cited references provide no disclosure, teaching, or suggestion of how to develop environmental performance

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scores at a vehicle, product, or service model level and instead teach reporting of "green scores" merely at a product configuration level. Thus, not only do the cited references and any combination thereof not meet all of Applicants' claim limitations, the cited references essentially teach away from Applicants' invention. As stated in the MPEP, if any of the cited references teach away from the suggested combination, or teach away from the claims, or render any of the cited references unsatisfactory for their intended purpose, the claimed invention is distinguishable over the combination of cited references. (MPEP § 2145) A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

Therefore, even if the combination as suggested by the Office Action were legally justified, Applicants' claims would still have novel and unobvious features over the proposed combination. In other words, any attempt at combining the cited references does not disclose all of the claimed features of Applicants' invention and, therefore, the combination would necessarily constitute a different method and different result than the claimed invention.

b. No Basis to Modify or Combine the Cited References

One of ordinary skill in the art would have no basis for combining the teachings of the ACEEE reference, Official Notice, www.bbbonline.org, and the "Fuel economy" reference in order to attempt to replicate Applicants' invention, because there is no suggestion or motivation in the art to do so. It is well settled patent law that a sustainable obviousness rejection requires "some teaching, suggestion, or motivation to combine the references," as summarized by *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998).)

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The cited references themselves contain no suggestion whatsoever for combining the references to teach the invention as claimed according to Applicants' disclosure. In other words, there is nothing in the references alone or together that suggest the claimed invention as a solution to the problem of environmental performance rating systems that are not compatible with industry or consumer needs and, in fact, Applicants' had to invent a solution to that problem.

The solutions taught by the ACEEE reference are directed to a problem totally different than that of Applicants' invention. For example, the ACEEE reference is directed to the problems associated with environmental performance claims of automakers that are based on laboratory tests which have a poor relation to typical driving. The ACEEE reference teaches development of "green scores" on a vehicle configuration level that account for the discrepancy between lab tests and real-world driving. In fact, Applicants' teachings are directed to a problem not even recognized in the cited references when considering all the cited references singularly or collectively. Not a single applied reference mentions the potential problem of environmental performance rating systems being incompatible with consumer or industry needs. Absent a recognition of this problem, it would be impossible for its solution to be obvious to any one, and the cited references cannot possibly suggest, singularly or in combination, a solution as novel as Applicants' invention.

In view of a lack of suggestion from the cited references, a person of ordinary skill in the art would not seek to combine these references cited in the Office Action to produce the results that Applicants' invention teaches. It is only through Applicants' own teachings and disclosure that one of ordinary skill in the art would appreciate the need for a step of

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developing forecasts of sales of product or sales configurations, and a step of developing environmental performance scores for product or sales models by sales-weighting environmental performance values of environmental data components by the forecasts of sales in order to solve the deficiencies in the environmental performance reporting of the prior art. In other words, but for Applicants' disclosure, there is no teaching, suggestion, or motivation whatsoever to combine the ACEEE reference, Official Notice, www.bbbonline.org, and the "Fuel economy" reference in any way in order to obviate Applicants' invention.

Applicants' invention is thus an unobvious improvement over the cited references and not an obvious modification or combination of any of the references of record in this application. When viewed singularly or collectively, none of the cited references discloses, teaches, or even suggests a step of developing forecasts of sales of product or service configurations, and a step of developing environmental performance scores for product or service models by sales-weighting environmental performance values of environmental data components by the forecasts of sales and, in fact, Applicants' method performs this for the first time. Thus, independent claims 15 and 45 are not rendered obvious by any of the cited references. Under principles of claim dependency and for at least the reasons stated above, the cited references do not render obvious any of the dependent claims either.

III. CONCLUSION

In view of the foregoing remarks, the Applicants respectfully submit that the pending independent and dependent claims are in proper form, define patentably over the cited

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references, and are all allowable. Applicants, therefore, respectfully request that a formal and timely Notice of Allowance of the application be issued

If the Examiner has any questions with respect to any matter now of record, the Applicants' attorney may be reached at the telephone number below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

REISING, ETHINGTON,
BARNES, KISSELLE, P.C.

Date: _____

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I hereby certify that this correspondence is being filed via facsimile on TBD with Examiner Smith, Group Art Unit 3625 at facsimile number 703.872.9306.

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